## REMARKS

Upon entry of the present amendment, claims 1-17 will remain pending in the above-identified application and stand ready for further action on the merits. Claims 1, 5, 13 and 17 have been amended herein, and the title of the specification has been amended herein. The amendments made herein to the title and claims do not incorporate new matter into the application as originally filed. For example, it is submitted that ample support for the amendments made herein to claims 1, 5 and 17 occur in original Figures 1 and 4 of the application, and at page 14, lines 7-20 of the specification. The amendment to claim 13 simply corrects a minor grammatical error (without changing the scope of the claim).

***Title of Invention***

In the office action, the Examiner contends that the original title of the invention is not descriptive. A new title for the invention is provided herein, which is clearly descriptive of the invention to which the claims are directed.

***Claim Rejection – 35 USC § 103(a)***

Claims 1, 3-4 and 9 have been rejected under the provisions of 35 USC § 103(a) as being rendered obvious by Nickum US '195 (US 2001/0039195), and further in view of Hawkins et al. US '202 (US 6,516,202) and Usui US '839 (US 2002/0025839).

Claim 17 has been rejected under the provisions of 35 USC § 103(a) over Nickum US '195, and further in view of Hawkins et al. US '202 and Wang US '506 (US 2003/0013506).

Claims 5, 7-8, 10 and 13-14 have also been rejected under the provisions of 35 USC § 103(a) over Nickum US '195, and further in view of Hawkins et al. US '202 and Nakai US '567 (US 6,928,567).[1]

Reconsideration and withdraw of the above rejections is respectfully requested based on the amendments made herein to the claims and the following considerations.

*Legal Standard for Determining Prima Facie Obviousness*

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

"There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In re Rouffet,* 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998)

[1] At page 7 of the Office Action, the Examiner also appears to cite Bryne US '231 (US 6,650,231) as a secondary reference against claims 10 and 14, but did not refer to the Bryne US '231 reference in the body of the original rejection. Applicants will assume the Examiner meant to apply Bryne US '231 as a secondary reference in support of the original stated rejection of claims 10 and 14.

(The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obvious was held improper.). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

"In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification." *In re Linter*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab,* 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee.* 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

*Distinctions Over the Cited Art*

***Independent Claims 1 and 5***

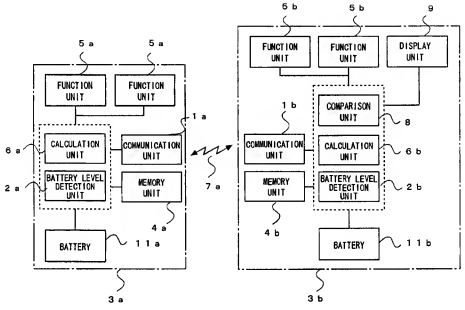
In the present invention, a comparison unit which compares the external battery level data (or operating time data) with battery level data of the small electronic device (or its own operating time data) is disclosed (*see Figure 1, comparison unit 8*). [**Figure 1** of the application is reproduced below for the Examiner's convenience.] The external battery level data is detected by the external device is detected by the battery level detection unit of its own.

Further, the small electronic device displays a comparison result compared by the comparison unit.

The comparison unit of the present invention is not disclosed or suggested in any of the prior cited against the pending claims, and no teaching or motivation is provided in the prior art that would allow one of ordinary skill in the art to arrive at the instant invention as claimed.

Accordingly, it is submitted that none of the cited art references of record provide any teaching or motivation that would allow one of ordinary skill in the art to arrive at the invention recited in pending claims 1 and 5, or any of dependent claims 2-4 and 6-8 that depend therefrom. Any contentions of the USPTO to the contrary must be reconsidered at present.

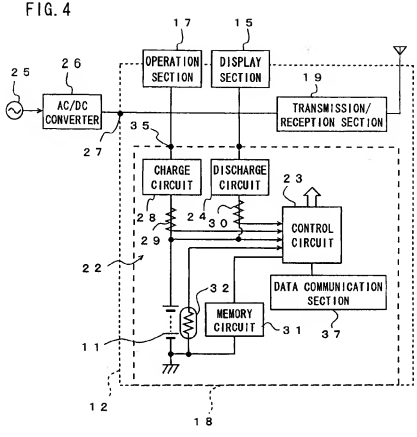
FIG. 1




***Independent Claim 17***

As recited in amended claim 17, the battery level detection unit of the present invention has a memory. According to this structure, the detection of a full-charge state and the add-up of charge and discharge levels are operated in accordance with the secondary battery **11** in use, using the battery characteristics data stored in the memory circuit **31** in the battery housing **18** (*see Fig. 4 and page 14, lines 7-20 of the specification*). [**Figure 4** of the application, and the disclosure at page 14, lines 7-20 of the specification are reproduced below for the Examiner's convenience.]

FIG. 4




Page 14, lines 7-20 of the specification:

*Further, the detection of a full-charge state and the add-up of charge and discharge levels are operated in accordance with the secondary battery **11** in use, using the battery characteristics data stored in the memory circuit **31** in the battery housing **18**. The calculated battery level and its time are always stored in the memory circuit **31**. If the battery housing **18** is temporarily removed from the main housing **12** and then attached back thereto, a self-discharge level is estimated from a time period during which the battery is separated and the discharge characteristics of the battery. The self-discharge level is then subtracted from the battery level before the removal of the battery housing **18**, thereby correcting the current battery level.* (emphasis added)

Accordingly, it is submitted that none of the cited art references of record provide any teaching or motivation that would allow one of ordinary skill in the art to arrive at the invention

recited in pending claim 17. Any contentions of the USPTO to the contrary must be reconsidered at present.

***Independent Claims 9 and 13***

Independent claims 9 and 13 are directed to monitoring methods and recite as follows:

**Claim 9**

*A monitoring method for monitoring a battery level, comprising the steps of:*

*detecting a battery level at a first small electronic device;*

*transmitting battery level data from the first small electronic device;*

*receiving the battery level data at a second small electronic device;*

*detecting a battery level at the second small electronic device;*

***comparing the battery level data of the first small electronic device with battery level data of the second small electronic device**; and*

*displaying a comparison result at the second small electronic device.*

(***emphasis added***)

**Claim 13**

*A monitoring method for monitoring a battery level, comprising the steps of:*

*detecting a battery level at a first small electronic device;*

*calculating an operating time from the battery level at the first small electronic device;*

*transmitting operating time data from the first small electronic device;*

*receiving the operating time data at a second small electronic device;*

*detecting a battery level at the second small electronic device;*

*calculating an operating time from the battery level at the second electronic device;*

***comparing the operating time data of the first small electronic device with operating time data of the second small electronic device**; and*

*displaying a comparison result at the second small electronic device.*

(***emphasis added***)

Upon review of each of the above two claims, it can be easily seen that each claim contains a comparing step of *"comparing the battery level data of the first small electronic device with battery level data of the second small electronic device"* (***Claim 9***), or *"comparing the operating time data of the first small electronic device with operating time data of the second*

*small electronic device" **(Claim 13)**.* As none of the cited art references of record provide any teaching or motivation that would allow one of ordinary skill in the art to arrive at the inventive methods recited in pending claims 9 or 13, which contain the above comparing steps, it follows that claims 9 and 13, and dependent claims 10-12 and 14-16 that depend therefrom. Any contentions of the USPTO to the contrary must be reconsidered at present.

***Allowable Subject Matter***

The Applicants very much appreciate the Examiner's courtesy in indicating that pending claims 2 (depends from claim 1) , 6 (depends from claim 5), 11-12 (depend from claim 9), and 15-16 (depend from claim 13) would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claim. Since it is submitted that each of independent claims 1, 5, 9, 13 and 17 is now in condition for allowance, it is not necessary to further amend claims 2, 6, 11-12 or 15-16.

**CONCLUSION**

In view of the above amendment, applicant believes the pending application is in condition for allowance. The Examiner is respectfully requested to issue a Notice of Allowance, clearly indicating that each of instantly pending claims 1-17 are allowed and patentable under the provisions of title 35 of the United States Code.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John W. Bailey (Reg. No. 32,881)

at the telephone number below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated:

Respectfully submitted,

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